



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/837,301	04/11/1997	ALASDAIR C. STEVEN	14014.0327	7408

23859 7590 09/24/2002

NEEDLE & ROSENBERG P C
127 PEACHTREE STREET N E
ATLANTA, GA 30303-1811

EXAMINER

COOK, LISA V

ART UNIT	PAPER NUMBER
----------	--------------

1641

DATE MAILED: 09/24/2002

30

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/837,301

Applicant(s)

STEVEN ET AL.

Examiner

Lisa V. Cook

Art Unit

1641

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 August 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 57-97 is/are pending in the application.
- 4a) Of the above claim(s) 68-97 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 57-67 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 57-97 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

Art Unit: 1641

DETAILED ACTION

Continuation Application

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/26/02 has been entered.

Applicants' request to consider the amendment filed 7/24/02 under 37 CFR 1.116 (Paper #29 filed 8/26/02) is acknowledged. Currently, claims 57-67 are under consideration.

OBJECTIONS WITHDRAWN

Oath/Declaration

2. A new oath or declaration is required because:
- A. Non-initialed and/or non-dated alterations have been made to the oath or declaration. See 37 CFR 1.52(c). Please see the entries for citizenship for each inventor.
 - B. Applicant has not given a post office address anywhere in the application papers as required by 37 CFR 1.33(a), which was in effect at the time of filing of the oath or declaration. A statement over applicant's signature providing a complete post office address is required.
 - C. The specification to which the oath or declaration is directed has not been adequately identified. See MPEP § 601.01(a). Please check the appropriate line.

The wording of an oath or declaration cannot be amended. If the wording is not correct or if all of the required affirmations have not been made or if it has not been properly subscribed to, a new oath or declaration is required. The new oath or declaration must properly identify the application of which it is to form a part, preferably by application number and filing date in the body of the oath or declaration. See MPEP §§ 602.01 and 602.02.

Art Unit: 1641

Applicants have submitted a new Declaration (paper #22 filed 2/19/02) to overcome the objections.

OBJECTIONS MAINTAINED

Specification

3. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification. The disclosure is objected to because of the following informalities: The first page of the specification is not numbered. Appropriate correction is required.

Drawings

4. The drawings in this application are objected to by the Draftsperson under 37 CFR 1.84 or 1.152 (see PTO-948). Applicant is required to submit a proposed drawing correction in reply to this Office action. However, formal correction of the noted defect can be deferred until the application is allowed by the examiner. Applicant has deferred response to this objection until the instant application is allowed. Objection is maintained.

Information Disclosure Statement

5. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the Examiner on form PTO-892 or Applicant on form PTO-1449 has cited the references they have not been considered.

NEW GROUNDS OF REJECTION NECESSITAED BY AMENDMENT

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 57-67 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant's proposed amendment to claim 57 where in "is bound to" is replaced by "interacts with" introduces a claim limitation that does not have support in the instant disclosure. Applicant is invited to show support in the specification for the new limitation.

REJECTIONS MAINTAINED

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 1641

I. Claims 57-67 are rejected under 35 U.S.C. 102(a) as being anticipated by Ren et al. (Protein Science (1996), Vol.5, pages 1833-1843).

Ren et al. teach compositions in which molecules of interest are displayed through polymer binding. The polymers are T4 capsids and polyheads (tubular capsid variants) and the display molecules are derivatives of the dispensable capsid protein SOC. (Abstract). In figure 1, on page 1834 – the principle of the SOC display system is outlined. A surface lattice of the T4 capsid contains two dispensable proteins, SOC and HOC (claims 64 and 65). The surface lattice protein is a hexagonal array of hexamers of protein gp23*. HOC and SOC bind to the outer surface of the gp23* lattice: a HOC monomer binds at the center of each hexamer, and trimers of SOC bind around the trigonal sites. Peptides or polypeptides (examples with 4-residue and 316-residue peptides are shown) are expressed/displayed as C-terminal fusions of SOC and bind to the display platform. The mature surface lattice does not dissociate over a wide range of concentrations and environmental conditions.

The composition is taught to be suitable in expressing an antigen (see page 1838), an enzyme see page 1839-(induce T-cell response), and an immunoglobulin (see page 1836-Immunogenicity of SOC-V3 phage). Also see page 1839-Potential application of the SOC system.

Response to Arguments

Applicant argues that the cited reference lists co-inventors and is properly cited. Accordingly applicant will file a Katz-type declaration to resolve the issue. The rejection is maintained.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

I. Claims 57, 62, 63, 64, 66, and 67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ladner et al. (USP#5,403,484) in view of Macdonal et al. (Embryo Journal, 12/1984, Vol.3, No.12, pages 2863-2871)-ABSTRACT ONLY.

Ladner et al. (USP#5,403,484) show that viruses expressing chimeric binding proteins can be useful in producing novel enzymes and hormones. (column 16, lines 1-8). Novel binding proteins against a molecule of interest encoding a protein comprising a binding domain are utilized to display a protein on the outer surface of a chosen bacterial cell, spore, or phage. See abstract.

Art Unit: 1641

The protein may be expressed as an insert in a chimeric bacterial outer surface protein (OSP). "All bacteria exhibit proteins on their outer surface". Column 60, lines 58-61. In order to obtain appropriate display it may be necessary to add one or more linkers amino acids between the OSP and the potential binding domain (PBD). Column 71, lines 13-22.

Ladner et al. differ from the instant invention is not specifically employing a T4 phage in the chimeric composition.

However, MacDonald et al. disclose DNA sequence and transcriptional patterns in T4 phage (*T4 surface lattice protein array*). The T4 phage is taught to be a suitable lattice protein in the instant invention. See the specification, page 2, lines 1-2 and page 12, lines 11-18. In an area between 15 and 18 kb on the standard phage T4 map, the novel gene 69 is localized. This 69 gene (*molecule of interest*) codes for two overlapping proteins that share a common C-terminal segment. The two proteins are expressed from different transcripts that are under different regulation.

The smaller protein, gp69*, can be expressed from a Escherichia coli-like promoter, but the expression of the larger protein, gp69 is delayed. The gene (69) is bracketed by DNA adenine methylase (*linker*) and the late gene SOC (*T4 dispensable polypeptide*).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the T4 phage surface lattice protein as taught by MacDonald et al. in a chimera composition as disclosed by Ladner et al. to produce outer capsid molecule display, because such T4 phage molecules as taught by MacDonald et al. are well known in the art. A person of ordinary skill in the art would have had a reasonable expectation of success utilizing T4 phage given the knowledge on its detailed structure.

Art Unit: 1641

One having ordinary skill in the art would have been motivated to do this because MacDonald et al. taught that the DNA sequence and transcription patterns on the standard phage T4 map is interdigitated in a complex pattern that reveals all elements that are thought to be important in regulation of the T4 gene. See abstract.

II. Claims 58, 59, 60, 61, and 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ladner et al. (USP#5,403,484) in view of Macdonal et al. (Embryo Journal, 12/1984, Vol.3, No.12, pages 2863-2871)-ABSTRACT ONLY and in further view of U. Aebi et al. (J. Mol. Biol., 1977, 110, pages 687-698) and.

Please see discussion of Ladner et al. in view of Macdonald et al. as set forth above.

Ladner et al. in view of Macdonald et al. differ from the instant invention in failing to teach the dispensable polypeptide-HOC and the different types of molecules of interest that may be expressed in this system (antigen, enzyme, or immunoglobulin).

However, U.Aebi et al. disclose that the T4 phage has two dispensable capsids namely, soc and hoc. (page 687)

Ladner et al., Macdonald et al., and U. Aebi et al. are all analogous art because they are from the same field of endeavor, all three inventions teach expression techniques involving phage display.

Art Unit: 1641

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the HOC as a dispensable polypeptide and express antigens, enzymes, or immunoglobulins as specific molecules of interest as taught by U. Aebi et al. in the method of Ladner et al. in view of Macdonald et al. to perform outer capsid phage display, because such dispensable polypeptides and molecules of interest as taught by U. Aebi et al. are well known in the art. A person of ordinary skill in the art would have had a reasonable expectation of success utilizing such materials, because they were already shown to be operable in the prior art.

One having ordinary skill in the art would have been motivated to do this because U. Aebi et al. taught that compositions comprising soc and hoc lattices are much more stable. See page 697, 2nd paragraph.

Response to Arguments

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to the argument that Ladner et al. only discloses compositions wherein the molecule of interest is fused directly to a coat protein and is not linked by a linker, applicant is directed to sections Column 71, lines 13-22 of U.S. Patent #5,403,484. "In order to obtain appropriate display it may be necessary to add one or more linkers amino acids between the OSP and the potential binding domain (PBD)". Further the method by which the composition is made is not presently being considered. Only limitations, with respect to the actual composition will be given patentable weight.

Art Unit: 1641

Applicant contends that one of ordinary skill would not be motivated to link the dispensable polypeptides to another molecule via a linker and still retain the ability to bind intact phage. However, U. Aebi et al. taught that compositions comprising soc and hoc (dispensable polypeptides) and the lattices are much more stable and do not adversely effect phage display.

Given this teaching, one would be motivated to linking molecules of interest to the dispensable polypeptides in order to increase stability of the construct against dissociation and elevated temperatures while preserving the phage display capacity. See U. Aebi et al. page 697, 2nd paragraph.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e. the complex involves protein-protein binding only not a covalent bond) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's argument that a dispensable polypeptide can be linked to a molecule of interest and still retain binding ability, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Art Unit: 1641

9. For reasons aforementioned, no claims are allowed.

10. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform to the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The Group 1641 Fax number is (703) 308-4242, which is able to receive transmissions 24 hours/day, 7 days/week.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lisa V. Cook whose telephone number is (703) 305-0808. The examiner can normally be reached on Monday-Friday from 8:00 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le, can be reached on (703) 305-3399.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.



Lisa V. Cook

CM1-7B17

(703) 305-0808

9/9/02



CHRISTOPHER L. CHIN
PRIMARY EXAMINER
GROUP ~~1800~~ 1641